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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,530	12/28/2000	Raymond F. Ratcliff III	6000-011-52(IND-105)	6669

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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,530

Applicant(s)

KHOO ET AL.

Examiner

Jason P. Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9-12,17,18,22,44-47,71,73,74,76,78,80-85 and 138-142 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9-12,17,18,22,44-47,71,73,74,76,78,80-85 and 138-142 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/13/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/6/2006 have been fully considered but they are not persuasive.

The declaration filed on 6/6/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Candelore and Alexander references.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Candelore reference.

The examiner notes that Applicant has submitted a copy of the new declaration (with evidence) to both the examiner and the mail-processing center of the USPTO. The examiner notes that these two sets of documents are completely different. For example, in Exhibit 5 note the cover page in the documents submitted to the examiner, which states that both Dennis Khoo and Trey Ratcliff are both named inventors and that the date is June 20, 1997. This information is not present on the documents that have been scanned into the electronic filing system (mailed to the mail-processing center), therefore the integrity of these documents cannot be determined (for example in Exhibit 5 the examiner cannot determine what portions were invented by Trey Ratcliff and what portions were invented by Dennis Khoo). The examiner has submitted the documents directly mailed to him to be officially entered into the record of the instant application.

In regards to the reduction to practice of the claimed invention, Exhibits 1-5 (in both submitted copies) merely state the conception of the idea of the claimed subject

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matter and provide no evidence of a reduction to practice of the claim subject matter.

The examiner notes that in order to show an actual reduction to practice that evidence of an actual implementation of the system claimed must be provided. In regards to Exhibit 6, the source code provided (in addition to being unreadable) only discloses source code from a server portion, not a client portion (as stated by the Applicant himself), therefore Exhibit 6 does not teach a client/server system (as well as any interaction between the client and the server) and Applicant's statements regarding a single screen shot representing the client code, as well as the unreadable source code being representative of the server code is not evidence. Exhibit 7 is only a resume of the Applicant of record and provides no evidence of the claimed invention being reduced to practice.

Applicant has deleted inventor Dennis Khoo from this application (see approved changed of inventorship dated 6/21/2006) and provided a new declaration stating that the claimed subject matter only contains subject matter invented by Raymond F. Ratcliff, III. However, the 1.1.31 Declaration contains exhibits that name Raymond F. Ratcliff, III as well as Dennis Khoo. For example, the cover sheet of exhibit 5 (mailed directly to the examiner), which is dated June 20, 1997, clearly names both Dennis Khoo as well as Trey (Raymond F.) Ratcliff. By removing Dennis Khoo from the inventorship of the instant application, Exhibit 5 is moot because (as stated on the cover sheet of Exhibit 5) both Dennis Khoo and Raymond F. Ratcliff have both conceived the subject matter disclosed in Exhibit 5.

Furthermore, in regards to Exhibit 5, the integrity of the original document has been breached. For example, page 8 provides a copyright on the lower left corner that states "Individual Network, Inc. © 1997", while page 9 has no copyright and states "Individual Network, Inc." in the lower left corner and also appears to be an inserted copy of another document. Note that pages 17-18 provide the same inconsistency. Therefore, because of the inconsistency of the pages 8-9 and 17-18, the examiner cannot determine which portions of the document to consider before the critical date.

Also note that Exhibits 1-5 have been redacted, however the information redacted from these documents is not shown. A redacted document shows not only portions that Applicant wishes to convey, but also the information that the Applicant wishes to redact.

Because of the insufficient declaration, Candelore (as well as Alexander) still read on the claim limitations, which have been amended. The rejection is repeated below.

The examiner also notes that the claims have been significantly broadened and that after further search the examiner has found numerous prior art references, dated before the critical date that the Applicant is attempting to swear behind. The examiner will cite these references for the Applicant's consideration.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 6/13/2006 was filed after the mailing date of the Non-Final Rejection on 11/21/2005. The submission is in

compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 9-12, 17-18, 22, 44-47, 71, 73-74, 76, 78 and 80-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore (U.S. Patent No. 6,057,872) in view of Alexander et al. (U.S. Patent No. 6,177,931).

Referring to claim 1, Candelore discloses providing a reward for receiving content having a video component to at least one viewer over a data network (see Column 3, Lines 40-49).

Candelore also discloses transmitting the content over the data network to a reception device (see terminal 160 in Figure 1 and Column 6, Lines 17-26).

Candelore also discloses presenting on the reception device the content for a presentation period (Column 6, Lines 35-36).

Candelore also discloses providing a reward if the presenting of the content satisfies a predetermined condition associated with the reward (see Column 4, Lines 30-37 and Figure 7B).

Candelore also teaches that the rewards can be sent to the viewer based on a viewer's profile (see Column 4, Lines 16-30), but fails to disclose that the content is transmitted to the reception device in accordance with a customized schedule based on information about the at least one viewer.

Alexander teaches a targeted advertisement system, which customizes video programming, as well as video advertisements (content) to a specified user using a user profile, which is based off the user's viewing habits (see Column 32, Lines 23-67 and Column 33 and 34, Lines 1-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the television reward system, as taught by Candelore, using the targeted advertising system, as taught by Alexander, for the purpose of providing customized video and/or advertising to the viewer (see Column 2, Lines 20-21 of Alexander).

Claim 9 corresponds to claim 1, where Candelore further discloses requesting, by the reception device over the data network, the content from a server (see headend 110 in Figure 1 and Column 2, Lines 4-9 for a VOD service (which is one of many different services provided by Candelore), which allows a user to request content from a server).

Candelore also discloses retrieving, by the content providing server, the content requested (see again Column 2, Lines 4-9).

Candelore also discloses transmitting the content to the content reception device through the data network (see again Column 2, Lines 4-9).

Note that selecting a video-on-demand movie by a user consists of requesting the movie (by the user), retrieving the movie (from a video server), and transmitting the movie back to the user.

Also note the rejection of claim 1, for how Alexander adds the functionality of providing “customized (video) content” to the viewer.

Claim 10 corresponds to claim 9, where Alexander discloses transmitting, by the reception device, information regarding characteristics of the at least one viewer, and storing, by the server, the information regarding characteristics of the at least one viewer (see Column 29, Lines 14-21).

Claim 11 corresponds to claim 9, where Alexander discloses that the reception device requests customized content based on a demographic of the at least one viewer (see Column 30, Lines 53-58 and note that if the EPG is customized, then the user would inherently be requesting “customized content”).

Claim 12 corresponds to claim 1, Alexander discloses displaying the content on an intelligent television (see Column 8, Lines 66-67 and Column 9, Line 1).

Claim 17 corresponds to claim 1, Alexander discloses displaying the customized content for presentation period sufficient to receive at least a portion of the customized content (see Figure 1, for the program “REMEMBER” being displayed from 9pm to 9:30pm). Therefore, since the EPG is customized (see the rejection of claim 11), the customized program “REMEMBER”, will be displayed for the time period specified by the EPG.

Claim 18 corresponds to claim 1, Candelore discloses the predetermined condition associated with the reward is defined to require that a presentation period exceed a predetermined threshold (see Figure 7B and Column 11, Lines 41-67 and Column 12, Lines 1-56).

Claim 22 corresponds to claim 1, Candelore discloses providing a monetary award to the viewer (Column 9, Lines 7-14).

Referring to claim 44, see rejection of claim 1. Also note that claim 44 further recites that the reward is provided based on the information about the at least one viewer (for example, note that the reward is provided by Candelore only if the user watches the content for a specified period of time (see Figure 7B), therefore the reward is provided based on the information of at least one viewer).

Referring to claim 45-46, see the rejection of claim 11.

Referring to claim 47, see the rejection of claim 12.

Referring to claim 71, see rejection of claim 9.

Referring to claims 73, Candelore discloses transmitting the reward from headend 110 in Figure 1, which also provides VOD content to the user. Also note that Alexander transmits "customized content" from the headend (see the rejection of claim 1).

Referring to claim 74, see rejection of claim 1.

Referring to claims 76 and 78, see the rejection of claim 18.

Referring to claim 80, see the rejection of claim 11.

Referring to claim 81, see the rejection of claim 22.

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Referring to claim 82, see the rejection of claim 11.

Referring to claims 83-85, see the rejection of claims 73-74 and 78, respectively.

Referring to claim 138, Alexander further discloses that the customized content includes customized advertising (see Column 32, Lines 23-67 and Column 33 and 34, Lines 1-67 of Alexander).

3. Claims 139-142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore (U.S. Patent No. 6,057,872) in view of Alexander et al. (U.S. Patent No. 6,177,931) in further view of Broadwin et al. (U.S. Patent No. 5,929,850).

Referring to claim 139, Candelore discloses providing a reward for receiving content having a video component to at least one viewer over a data network (see Column 3, Lines 40-49).

Candelore also discloses transmitting the content over the data network to a reception device (see terminal 160 in Figure 1 and Column 6, Lines 17-26).

Candelore also discloses presenting on the reception device the content for a presentation period (Column 6, Lines 35-36).

Candelore also discloses providing a reward if the presenting of the content satisfies a predetermined condition associated with the reward (see Column 4, Lines 30-37 and Figure 7B).

Candelore also teaches that the rewards can be sent to the viewer based on a viewer's profile (see Column 4, Lines 16-30), but fails to disclose that the content is

transmitted to the reception device in accordance with a customized schedule based on information about the at least one viewer.

Alexander teaches a targeted advertisement system, which customizes video programming, as well as video advertisements (content) to a specified user using a user profile, which is based off the user's viewing habits (see Column 32, Lines 23-67 and Column 33 and 34, Lines 1-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the television reward system, as taught by Candelore, using the targeted advertising system, as taught by Alexander, for the purpose of providing customized video and/or advertising to the viewer (see Column 2, Lines 20-21 of Alexander).

Candelore and Alexander fail to disclose that the reward comprises entering the viewer into a contest.

Broadwin discloses a system that provides advertising in the form of an entry form for a sweepstakes (see Figure 19 and Column 18, Lines 56-64).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertising system, as taught by Candelore and Alexander, using the sweepstakes entry form, as taught by Broadwin, for the purpose of providing a more simplified mechanism for displaying interactive advertising content (see Column 18, Lines 51-52 of Broadwin).

Claim 140 corresponds to claim 139, where Broadwin further discloses that the contest is targeted to the at least one viewer based on information about at least one

viewer (see Column 18, Lines 56-64 for the advertising (which is targeted to a particular user) in the form of a sweepstakes is transmitted to the viewer).

Claim 141 corresponds to claim 139, where Broadwin further discloses that the contest is a sweepstakes (see Column 18, Lines 56-64), and the at least one viewer is entered into the sweepstakes upon each instance that the customized content is displayed on the reception device (see Column 18, Lines 56-64 and Figure 19 for one instance of the sweepstakes advertisement/entry form being offered to the viewer, therefore, upon each single instance, where the entry form is filled out, the viewer is entered into the sweepstakes).

Claim 142 corresponds to claim 139, where Candelore further discloses that a report can be generated including information identifying the at least one winning viewer and the rewards received (see Column 6, Lines 42-67 and Column 7, Lines 1-12 for various types of contests that determine a winner and identify the coupons/rewards received by the viewer, in order to send more coupons/rewards that are similar to those previously received).

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce
Primary Examiner
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June 21, 2006

*Jason
Sulek*